

REMARKS**INTRODUCTION:**

In accordance with the foregoing, the specification has been amended to more clearly relate aspects of the shown embodiments, and claims 1, 9, 14, and 24 have been amended. Claims 1-30 and 32-34 are pending and under consideration. Reconsideration is requested.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because:

- (1) the amendments of claims 1, 9, 14, and 24 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and
- (2) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

OBJECTION TO CLAIM:

On page 2 of the Office Action, the Examiner requests claims 1 and 14 to be amended in order to clarify a feature. While it is believed that claims 1 and 14 were previously presented in a manner consistent with 35 U.S.C. §112 as would be understood by one of ordinary skill in the art, claims 1 and 14 have been amended to clarify the feature without narrowing the scope of the claims. As such, it is respectfully submitted that the Examiner's request has been satisfied.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action at page 2, the Examiner rejects claims 9, 10, and 20 under 35 U.S.C. §102 in view of Lee (European Patent Publication 0 973 160 A1). This rejection is respectfully traversed and reconsideration is requested.

By way of review, Lee discloses a laser source 310 which projects a first light beam onto a hologram 330 and a light source 320 which projects a second light beam onto the hologram 330 at another angle. Light from the hologram 330 is received at the corresponding media 370, 372 via a beam splitter 340, collimating lens 350, and objective lens 360. While the objective lens 360 is disclosed as compensating for aberrations, there is no suggestion as to whether the objective lens 360 uses an aspherical surface or surfaces to correct this aberration in addition to or instead of the hologram 350. (Paragraphs 0012 & 0022).

On page 3 of the Office Action, the Examiner clarifies that the objective lens 360 inherently includes a concave surface and a convex surface corresponding to the aspherical curvatures of the regions as recited in claim 9. However, the Examiner does not provide evidence that the objective lens 360 necessarily includes the aspherical curvatures at the objective lens 360 which correspond to the features as presented in claim 9.

Generally, where the Examiner relies upon the theory of inherency, the Examiner is required to provide extrinsic evidence that the features are necessarily present in the reference. As noted in MPEP 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (emphasis in original). Since the Examiner has not provided evidence that the objective lens 360 necessarily discloses aspherical curvatures, it is respectfully submitted that the Examiner has not provided sufficient evidence to rely on Lee inherently disclosing such features as set forth in the Office Action.

While it is believed that the objective lens 360 does not disclose the features of claim 9 as previously presented, claim 9 has been amended to clarify the location of the curvatures

without narrowing the scope of the claim as previously presented. As such, it is respectfully submitted that Lee does not disclose or suggest, among other features, "an objective lens disposed on the common optical path to focus the selectively emitted first and second light beams on the respective first and second recording media, the objective lens having a surface with at least one region having a different aspheric curvature from an aspheric curvature of another section of the surface such that the first and second light beams are focused on the respective first and second recording media" as recited in claim 9.

Claims 10 and 20 are deemed patentable due at least to their depending from claim 9.

STATUS OF CLAIMS NOT REJECTED:

On page 3 of the Office Action, the Examiner allows claims 1-8, 11-13, 15-19, 22, 23, and 25-30, and objects to claims 14, 21, and 24 for depending from rejected claims.

JOINT RESEARCH EXCLUSION STATEMENT:

On page 3 of the Office Action, the Examiner asserts that the applicants invoked a joint research agreement exception set forth in 35 U.S.C. §103(c) in the Amendment of June 27, 2005. However, it is respectfully submitted that no such exception has been invoked, and that the June 27, 2005 Amendment does not contain a submission for said exception. As such, it is believed that the statement is a typographical error and should be withdrawn to clarify the record.

CONCLUSION:


In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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